

REMARKS

Claims 1-5 were pending in this application as of the November 24, 2004 mailing date of the current office action, and each claim stood rejected pursuant to either 35 U.S.C. §102 or 35 U.S.C. §103.

Applicants respectfully traverse these rejections, which Applicants submit are overcome or demonstrated to be inappropriate in view of at least the amendments above and/or the remarks that follow.

As indicated above, claims 2 and 3 have been canceled herein and their features have been incorporated into claim 1. Also, the dependencies of claim 4 (which previously depended from now canceled claim 3) and claim 5 (which previously depended from now canceled claim 2) have been switched to claim 1.

Applicants note for the record that claim 1 is amended and claims 2 and 3 are canceled herein solely to expedite allowance of this application. By amending claim 1 and canceling claims 2 and 3, Applicants do not dedicate the subject matter of these claims - as filed - to the public and do not acquiesce to the Examiner's current rejections of these claims, or to the reasons offered by the Examiner in support of such rejections. Applicants also respectfully reserve the right to seek patent protection for claims that are similar and/or identical to claims 1, 2 and 3 - as originally filed - in one or more related applications.

Claim Rejections - 35 U.S.C. §102 and 35 U.S.C. §103

In the current office action, the Examiner has rejected claims 1, 2 and 5 pursuant to 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,920,758 to Ohtsuki. ("the Ohtsuki patent"), and claims 3 and 4 pursuant to 35 U.S.C. §103(a) as being unpatentable over the combination of the Ohtsuki patent and U.S. Patent No. 5,513,839 to Green ("the Green patent").

As noted above, independent claim 1 has been amended herein to incorporate the features of claim 2, which recited that one side and the front of the inner empty space of the housing of the image forming apparatus are contiguously open to the exterior of the apparatus, and to include the features of claim 3, which recited that the image forming apparatus further comprised a shifter mechanism for incorporating sheet output rollers which are used as offset rollers for offsetting printed sheets along a direction perpendicular to a sheet transport direction in order to selectively discharge the printed sheets *to different sheet delivery positions* on the sheet delivery portion.

Applicant submits that amended claim 1 is patentable over the cited references because none of these references - either alone or in combination - discloses the various elements, and their arrangement, that are recited in claim 1. For example, the shifter mechanism of claim 3 (now of claim 1) was rejected over the combination of the Ohtsuki patent and the Green patent, yet neither patent, nor any combination thereof, discloses a shifter mechanism that allows for grasping and removal of sorted copies of printed sheets from either the front or the side of the image forming apparatus.

Also, the resulting combination of features that are now recited in claim 1 would not have been obvious to one of ordinary skill in the art based on a fair reading of the Ohtsuki patent and the Green patent. Only through the influence of hindsight could it be concluded that the features of amended claim 1, and the arrangement of such features, would be obvious to one of ordinary skill in the art. However, it is improper to base a claim rejection on hindsight, as spelled out, for example, by *Interconnect Planning Corp. v. Feil*, 227 USPQ 543,551 (Fed. Cir. 1985), which held that one cannot select separate components of an invention from the prior art for combination with the blueprint supplied by the inventor to support a rejection pursuant to 35 U.S.C. §103, and which further held that when prior art references are combined to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. These sentiments were echoed in the CAFC case of *Crown Operations International Ltd. v. Solutia Inc.*, 62 USPQ2d 1917, 1922 (Fed. Cir. 2002), in which the court cited to several of its earlier decisions in order to emphasize that:

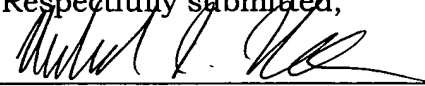
"[d]etermination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ATD Corp. v. Lydall, Inc.*, 48 USPQ2d 1321, 1329 (Fed Cir. 1998). There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. See *Ruiz v. A.B. Chance Co.*, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); *ATD Corp*, 48 USPQ2d at 1329; *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination.").

These cases underscore that there must be a suggestion or motivation to combine references in order to support a rejection based on 35 U.S.C. §103(a), and that the suggestion or motivation must not be influenced by hindsight that is based, for example, on the teachings contained within the specification of the application being examined. Yet such motivation or suggestion would not exist regarding claim 1 absent improper hindsight.

In sum, Applicants submit that claim 1 is patentable over the cited references, and that any conclusion to the contrary could only be based on improper hindsight. For at least this reason, claim 1 is believed to be allowable. Moreover, wherein claim 1 is allowable, so to are claims 4 and 5, each of which depends directly from claim 1, and, therefore, includes the patentable features thereof.

In view of at least the amendments and/or remarks herein, claims 1, 4 and 5 of this application are believed to be in condition for allowance. Reconsideration and allowance of these claims are respectfully requested. If the undersigned can be of any assistance in advancing the prosecution of this case, the Examiner is invited to contact him through the information given below.

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Respectfully submitted,

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